

Dated: October 27, 2008
888736 / 32639

The Schmid paper is prior art to U.S. Patent No. 6,864,904 (the “’904 patent”). Girafa admitted this in its July 30, 2008, Information Disclosure Statement (“IDS”), Opening Br. at Ex. A, despite on three separate occasions, both before and after filing that IDS, arguing before this Court that the same Schmid paper was *not* prior art because the publication date had not been established.

Confronted with these facts, Girafa claims that the Amazon Defendants disregarded a disclaimer in the IDS that states that the documents cited are not necessarily prior art and that Girafa reserved the right to challenge the publication date of any cited reference. Girafa points to the following language from the IDS:

This IDS should not be construed as a representation . . . that any cited document listed or attached is (or constitutes) prior art. . . and Applicant reserves the right to prove that the date of publication is in fact different.

Girafa’s Opp. Br. at 2 (quoting portions of Girafa’s IDS, Opening Br. at Ex. A, pg. 4, ¶ 6).

But the cropped quote from the IDS leaves out a critical clause, which requires a party to identify that a listed publication date did not come from the face of the publication when that is the case:

This IDS should not be construed as a representation . . . that any cited document listed or attached is (or constitutes) prior art. **Unless otherwise indicated, the date of publication indicated for an item is taken from the face of the item** and Applicant reserves the right to prove that the date of publication is in fact different.

Opening Br. at Ex. A, pg. 4 at ¶ 6 (emphasis added to show the relevant portion of its IDS that Girafa did not disclose to the Court).¹ In other words, unless a party says otherwise, by specifically listing a date the party is representing to the PTO that the date comes from the face of the publication (and that the party reserves the right to challenge the date). Here, the Schmid

¹ Girafa claims that the Amazon Defendants did not disclose the disclaimer in their opening brief. Opp. Br. at 1. In fact, the Amazon Defendants attached the entire IDS as an exhibit to its opening brief, including paragraph 6 which Girafa relies upon. Opening Br. at Ex. A.

paper has no date on its face. Despite that fact, Girafa did not “indicate otherwise,” thereby representing to the PTO that March 1998 was the date listed on the reference, when in fact it was not.

Girafa appears to be making this up as it goes along. Girafa’s current story, that it listed the March 1998 date only because it was a position taken by the Amazon Defendants, is not consistent with what it said in the IDS. If Girafa believed that the Schmid paper had a later publication date than March 1998, it should have explained that in the IDS by making it clear that the listed date came from the Amazon Defendants, not the reference, and that Girafa disputed it. Instead, Girafa was silent in just listing the date represented to the PTO, March 1998, as the Schmid paper’s publication date, and Girafa has to live with that. Why Girafa did this when the Schmid paper admittedly has no publication date on it is a mystery – perhaps Girafa has strategic prosecution reasons for taking this position on the date of publication of Schmid. In any case, this Court should hold Girafa to its admission there, as Girafa cannot be allowed to take conflicting positions when it suits its interests. The Court should thus declare the filing date of the Schmid paper to be March 1998 and grant the Amazon Defendants their costs, expenses, and attorneys fees pursuant to 28 U.S.C. § 1927.

OF COUNSEL:

Thomas G. Pasternak
R. David Donoghue
DLA PIPER US LLP
203 N. LaSalle Street, Suite 1900
Chicago, IL 60601-1293
Tel: (312) 368-4000

M. Elizabeth Day
Gregory J. Lundell
DLA PIPER US LLP
2000 University Avenue
East Palo Alto, CA 94303-2248
Tel: (650) 833-2000

Dated: October 27, 2008
888736 / 32639

POTTER ANDERSON & CORROON LLP

By: /s/ David E. Moore
Richard L. Horwitz (#2246)
David E. Moore (#3983)
Hercules Plaza, 6th Floor
1313 N. Market Street
Wilmington, DE 19899
Tel: (302) 984-6000
rhorwitz@potteranderson.com
dmoore@potteranderson.com

*Attorneys for Defendants
Amazon Web Services LLC, Amazon.com, Inc.,
and Alexa Internet, Inc.*

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

CERTIFICATE OF SERVICE

I, David E. Moore, hereby certify that on October 27, 2008, the attached document was electronically filed with the Clerk of the Court using CM/ECF which will send notification to the registered attorney(s) of record that the document has been filed and is available for viewing and downloading.

I further certify that on October 27, 2008, the attached document was Electronically Mailed to the following person(s):

Steven J. Balick
John G. Day
Tiffany Geyer Lydon
ASHBY & GEDDES
500 Delaware Avenue, 8th Floor
Wilmington, DE 19899
sbalick@ashby-geddes.com
jday@ashby-geddes.com
tlydon@ashby-geddes.com
Attorneys for Plaintiff Girafa.com, Inc.

William H. Mandir
John F. Rabena
Trevor C. Hill
Chandran B. Iyer
SUGHRUE MION, PLLC
2100 Pennsylvania Ave., N.W.
Washington, D.C. 20037
wmandir@sughrue.com
jrabena@sughrue.com
thill@sughrue.com
cbiyer@sughrue.com
Attorneys for Plaintiff Girafa.com, Inc.

Anne Shea Gaza
RICHARDS, LAYTON & FINGER
One Rodney Square
P.O. Box 551
Wilmington, DE 19899
gaza@rlf.com
Attorneys for Defendant IAC Search & Media Inc.

Antonio R. Sistos
Jennifer A. Kash
Alison Monahan
QUINN EMANUEL URQUHART OLIVER &
HEDGES, LLP
50 California Street 22nd Floor
San Francisco, CA 94111
antoniosistos@quinnemanuel.com
jenniferkash@quinnemanuel.com
alisonmonahan@quinnemanuel.com
Attorneys for Defendant IAC Search & Media Inc.

Claude M. Stern
QUINN EMANUEL URQUHART OLIVER &
HEDGES, LLP
555 Twin Dolphin Dr., Suite 560
Redwood Shores, CA 94065
claudestern@quinnemanuel.com
*Attorneys for Defendant IAC Search &
Media Inc.*

Daniel M. Cislo
Mark D. Nielsen
CISLO & THOMAS LLP
1333 2nd Street, Suite 500
Santa Monica, CA 90401
dan@cislo.com
mnielsen@cislo.com
Attorneys for Snap Technologies Inc.

Harold V. Johnson
Scott A. Timmerman
BRINKS HOFER GILSON & LIONE
NBC Tower, Suite 3600
455 North Cityfront Plaza Drive
Chicago, IL 60611-5599
hjohnson@usebrinks.com
stimmerman@usebrinks.com
*Attorneys for Defendants Exalead Inc.
and Exalead S.A.*

Jack B. Blumenfeld
Rodger D. Smith II
MORRIS, NICHOLS, ARSHT & TUNNELL
1201 North Market Street
Wilmington, DE 19899-1347
jblumenfeld@nmat.com
rsmith@mnat.com
Attorneys for Defendant Yahoo! Inc.

Arthur G. Connolly, III
CONNOLLY, BOVE, LODGE & HUTZ
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899
aconnollyIII@cblh.com
Attorneys for Snap Technologies Inc.

Thomas C. Grimm
MORRIS, NICHOLS, ARSHT & TUNNELL
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899
tgrimm@mnat.com
*Attorneys for Defendants Exalead Inc. and
Exalead S.A.*

Justin Lim
2156
Montreal, Quebec H8N 1K7
Canada
jhlim@smartdevil.com
Attorneys for Defendant Smartdevil Inc.

Matthew D. Powers
Douglas E. Lumish
Yen P. Nguyen
WEIL, GOTSHAL & MANGES LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
matthew.powers@weil.com
doug.lumish@weil.com
titi.nguyen@weil.com
Attorneys for Defendant Yahoo! Inc.

/s/ David E. Moore

Richard L. Horwitz

David E. Moore

Potter Anderson & Corroon LLP

Hercules Plaza – Sixth Floor

1313 North Market Street

P.O. Box 951

Wilmington, DE 19899-0951

(302) 984-6000

rhorwitz@potteranderson.com

dmoore@potteranderson.com

842506 / 32639